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In re Application of	:	
Adam J. Katz et al	:	
Serial No.: 09/936,665	:	CORRECTION OF INVENTORSHIP
Filed: September 10, 2001	:	
Attorney Docket No.: 304488.77USW1	:	

SECOND REVISED DECISION

This is in reply to the Petition for Correction of Inventorship under 37 CFR 1.48(b), filed November 24, 2003, to correct the inventorship in the above identified application. The petition was resubmitted to the Office on January 21, 2004 and August 31, 2004. The delay in acting on this petition is regretted.

On August 17, 2004, the above identified application issued as U.S. Patent No. 6,777,231, naming seven inventors. Thus, Applicants' petition under 37 CFR 1.48(b) became a petition under 37 CFR 1.324 after the application issued as a patent since 37 CFR 1.48(b) applies only to applications. See MPEP 1481.02 (explaining that “[w]hile a request under 37 CFR 1.48 is appropriate to correct inventorship in a nonprovisional application, a petition under 37 CFR 1.324 is the appropriate vehicle to correct inventorship in a patent” and further explaining that “... if a request under 37 CFR 1.48(A), (B), OR (C) is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under 37 CFR 1.324 . . .”).

On June 4, 2007, the petition was denied on the grounds that the requirements of 37 CFR 1.324 were not satisfied (“Original Decision”). 37 CFR 1.324 allows correction of inventorship in an issued patent via a petition, provided that the petition is accompanied by statements from each named inventor and the assignee that all agree to the correction. The Office explained that petition did not include the requisite statements and therefore failed to comply with the requirements of 37 CFR 1.324.

On July 25, 2007, Applicants' alleged representative engaged in a telephone interview regarding the denial, pointing out errors in the denial, for example, that the petition was not filed on February 14, 2005 as had been stated in the Original Decision. Following that interview, a further review of the prosecution of U.S. Patent No. 6,777,231 was undertaken.

On August 3, 2007, the Office issued a Revised Decision, vacating the Original Decision and granting the petition. The Office indicated that the petition was being considered under 37 CFR

1.48(b) and that all the requirements set forth in that rule were satisfied. Consequently, the Office indicated that a Certification of Correction would issue, listing only three inventors.

The Office sua sponte is reconsidering the Revised Decision of August 3, 2007, in this Second Revised Decision to correct errors in the Revised Decision. The Office notes that the petition under 37 CFR 1.48(b) met all of the requirements of that rule at the time of filing. However, since the petition was never acted on until after issuance of U.S. Patent No. 6,777,231, it could only be considered under 37 CFR 1.324, as explained above. Thus, the Office notes that it was in error to have considered the petition in the Revised Decision of August 3, 2007, under 37 CFR 1.48(b) and that the Office correctly considered the petition in the Original Decision of June 4, 2007, as under 37 CFR 1.324.

As explained in the Original Decision, 37 CFR 1.324 requires consent of all parties to a patent to agree to correction of the inventorship. "All parties" include all inventors and all assignees. It is to be noted that the requirement in 37 CFR 1.324 for statements from each named inventor and all assignees is a requirement of 35 U.S.C. § 256. That statute provides that "[w]henever a person is named in an issued patent as the inventor, ... and such error arose without any deceptive intention on his part, Director may, **on application of all the parties and assignees**, ... issue a certificate correcting such error." 35 U.S.C. § 256 (Emphasis added). Here, "all parties" have not submitted statements, consenting to the correction of inventorship of U.S. Patent No. 6,777,321. In fact, no statements have been submitted on behalf of any named inventor or any assignee.

In view of the unsatisfied requirement that all parties consent to the change of inventorship, the Revised Decision of August 3, 2007, is vacated. The petition under 37 CFR 1.48(b), which is being considered under 37 CFR 1.324, is **DENIED**. The Certificate of Correction noted in the previous decision has been withdrawn.

Should there be any questions with respect to this action, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the Office general facsimile number, 571-273-8300.

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